

REMARKS

This amendment is responsive to the Office Action mailed July 15, 2009. Claims 1-10 and 28-54 were pending in the application. With this amendment, Claims 1, 2, 5, 9, 28, 29, 32, 36, 38, 39, 42, and 46-49 have been amended, and Claims 6-8, 33-35, 43-45, 53, and 54 have been canceled. Thus, Claims 1-5, 9, 10, 28-32, 36-42, and 46-52 are now pending in the application.

Applicant respectfully requests reconsideration and allowance of the present application in view of the foregoing amendments and the following remarks.

Interview Summary

Prior to discussing the patentability of the claims, applicant thanks Examiner Subramanian for the time and courtesy he extended in a telephone interview conducted with the undersigned counsel on October 29, 2009. During the interview, proposed amendments to the claims were discussed and agreement was tentatively reached that the amendments would overcome the issues raised in the Office Action under Sections 101 and 112, as discussed further below. Additional amendments were discussed, including amending Claim 1 to include the subject matter of Claim 8 and the intervening Claims 6 and 7. Corresponding amendments would be made to Claims 28, 38, and 51. While tentative agreement was reached that these amendments would overcome the cited prior art, the Examiner reserved agreement as to patentability of the claims pending a further search. Applicant thanks Examiner Subramanian for his helpful thoughts and suggestions for advancing the prosecution of the application. The amendments presented herewith are consistent with the discussion in the Examiner interview.

Claims 51 and 52 Meet the Requirements of 35 U.S.C. § 112, Second Paragraph

In the Office Action, Claims 51-54 were rejected as allegedly being indefinite. The Office Action expressed concern over the use of "means for" terminology in Claims 51-54.

Applicant notes that Claim 51 recites a computer system defined by means for performing specified functions. Claim 51 and its dependent Claim 52 should therefore be interpreted pursuant to 35 U.S.C. § 112, sixth paragraph.

While the *functions* in Claim 51 are defined in sufficient detail so as to be clear and definite under 35 U.S.C. § 112, the claimed means are recited in such terms so as to remain within the ambit of Section 112, sixth paragraph. Certain terms in the specified functions are qualified in the claims through various "wherein" and "such" clauses, but the *structure* for performing the specified functions is determined based on the corresponding structure described in the specification and equivalents thereof. Applicant respectfully requests that Claims 51 and 52 be examined accordingly.

Claim 51 has been amended to incorporate the subject matter of Claims 53 and 54. Thus, Claims 53 and 54 have been canceled, rendering their rejection moot.

Applicants respectfully submit that Claims 51 and 52 meet the requirements of 35 U.S.C. § 112, second paragraph, and therefore request that the claim rejections under Section 112 be withdrawn.

Claims 28-37 and 48 Meet the Requirements of 35 U.S.C. § 101

The Office Action (page 3) rejected Claims 28-37 and 48 under 35 U.S.C. § 101 as allegedly being inoperative. In particular, the Office Action interpreted the elements of Claims 28-37 and 48 as corresponding solely to software elements that cannot, by themselves, perform the underlying functions. Without conceding the propriety of the rejection, applicant has amended Claim 28 to further define the "order routing computing component" and the "order execution computing component" as "compris[ing] one or more computing devices programmed" to implement the specified elements. Claim 28 and its dependent Claims 29-37 and 48 are submitted as claiming statutory subject matter under 35 U.S.C. § 101. Withdrawal of the claim rejections under Section 101 is respectfully requested.

Claims 1, 4, 28, 38, and 51 Are Patentably Distinct Over Claims 1, 9, 28, 31, and 32 of U.S. Patent No. 7,539,638

The Office Action (page 5) rejected Claims 1, 4, 28, 38, and 51 as being unpatentable on grounds of nonstatutory obviousness-type doubling patenting over Claims 1, 9, 28, 31, and 32 of U.S. Patent No. 7,539,638, which is owned by the assignee of the present application. Applicant has carefully considered Claims 1, 4, 28, 38, and 51 as amended herewith in view of Claims 1, 9, 28, 31, and 32 of U.S. Patent No. 7,539,638, and respectfully submits that the amended claims presented herewith are patentably distinct and overcome the double patenting rejection. Reconsideration and withdrawal of the double patenting rejection is requested.

Patentability of the Pending Claims Over May, Lupien, and Korhammer

In the Office Action, Claims 1, 28, 38, and 47-49 were rejected as allegedly being unpatentable over May (U.S. Patent Application Publication No. 2002/0138390) (hereinafter "May") in view of Lupien et al. (U.S. Patent No. 5,101,353) (hereinafter "Lupien"). Applicant respectfully disagrees and submits that a *prima facie* basis for rejecting the amended claims based on the cited art cannot be shown.

Claim 1

As noted in applicant's previous response, May is directed to "subject-based addressing" in an electronic trading system. The addressing scheme disclosed by May comprises a four-part subject code that includes a source field, a class field, a symbol field, and a currency field.

As per the abstract of May, the four-part subject code is derived by systematically dividing the perimeters, terms, and conditions of the various derivative instruments into four discrete parts. The source field identifies the source of the information. The class field identifies a principal product class into which the financial instrument falls. The symbol field provides the underlying structure of the derivative instrument; thus, it is the principal code used to define each instrument. The currency field provides the currency code of the instrument.

While the systems and methods of May are used in electronic trading, nowhere does May teach or suggest an element of "automatically causing a portion or all of an order to be simultaneously available for execution in both [an] internal market and an external market . . . wherein the same portion or all of the order is simultaneously available for execution by market participants in each of the respective internal and external markets," as claimed in Claim 1 of the present application.

The Office Action (page 6) repeated the rejection from the prior Office Action and again referred to "the entire disclosure of May especially Paragraphs 28, 31, 72, 109, 120-131, 258-265" in this regard. Applicant has studied the disclosure of May and finds nothing that supports the contentions made in the Office Action. In regard to order processing, May relies on conventional market systems in which an order is routed to a single market where it can be matched with an order of another party.

For example, the Office Action cited paragraph [0028] of May, which reads as follows:

In accordance with a first aspect of the present invention, a method for conducting electronic trades of financial instruments comprises the step of entering order data including a proposed trade of a financial instrument, wherein the financial instrument is defined by a symbology comprising a source field, a class field, a symbol field and a currency field. The order data can be distributed to potential traders, and then the proposed trade can be presented to at least one potential trader utilizing the symbology.

Nothing in the above quoted paragraph suggests automatically causing a portion or all of an order to be simultaneously available for execution in both an internal market and an external market.

The Office Action further cited paragraphs [0031] and [0072], which read as follows:

In accordance with yet another aspect of the present invention, a computer program product for use with a data processing system for conducting electronic trading between traders comprises a computer usable medium having computer-readable code means embodied in the medium, wherein the computer-readable code means comprises computer-readable code means for entering order data, wherein said order data comprises a financial instrument defined by a symbology comprising a

source field, a class field, a symbol field and a currency field. The a computer program product further comprises computer-readable code means for presenting the order data to at least one trader utilizing the symbology, and computer-readable code means for transmitting the order data to traders.

...

The present invention provides for a standardized contract definition, and means for matching complex credit preferences of each counterparty before a trade is executed. Therefore, potential counterparty users are able to identify bids and offers that they are eligible to trade based on credit preference information provided before initiating a trade. The present invention also permits users to place passive orders (bids or offers on the various financial products for other counterparties to actively choose from to hit (bids) or lift (offers), without the posting user doing anything further) or active orders (where the viewing user actively initiates the trade by selecting passive bids or offers which are already in the system). This gives a user maximum control over the order flow process. For instance, there may be a situation whereby the bids in a particular market are higher than the offers, but no trading is taking place. This situation may occur when the credit quality of the best offer (which in this case would be below the bid) would not be good enough for a bidder to be willing to enter into a transaction with that counterparty. This is a significant difference from the prior art systems in which orders are automatically matched if the prices are equal because such prior art systems typically limited the user's control over the order flow.

Again, as discussed in applicant's prior response, it is evident in May that all orders, active and passive, are handled within a single market. Nothing in May suggests causing a portion or all of an order to be simultaneously available for execution in both an internal market and an external market, as claimed in the present application.

Paragraphs [0109], [0120]-[0131], and [0258-0265] of May, as cited in the Office Action, also teach nothing that discloses or suggests the subject matter claimed in Claim 1 of the present application. May teaches a "command center interface" 130 that allows a user to select various instruments and simultaneously monitor the markets and place orders (see, e.g., paragraph [0258]), but this does not teach or suggest causing a portion or all of an order to be simultaneously available for execution in both an internal market and external market, as claimed in the present application.

Furthermore, May defines the term "market" differently than the present application. This point was not disputed in the current Office Action. According to May (e.g., at paragraph [0259]), each instrument that is traded makes a different "market." In contrast, the present application refers to internal and external "markets" in the sense of exchanges configured to execute trades between market participants. As per Claim 1, "the internal and external markets each have a plurality of market participants and are each separately capable of executing trades between the market participants." A portion or all of the order is "simultaneously available for execution in both the internal market and an external market."

To prevent unwanted duplicate execution of the order, the present application further discloses and claims "automatically controlling execution such that the simultaneously available portion or all of the order is executed in at most one of the internal market and the external market." The Office Action (page 6) conceded that May does not teach the element of "controlling execution of the order," and instead relied on the disclosure of Lupien.

Notwithstanding the Examiner's citation of the abstract; Col. 2, lines 60-67; Col. 3, lines 1-14; Col. 5, lines 63-67; Col. 6, line 1, to Col. 7, line 67; Col. 17, lines 73-67, and Col. 18, lines 1-49, of Lupien, applicant respectfully submits that Lupien fails to teach or suggest the element of "automatically controlling execution of the order such that the simultaneously available portion or all of the order is executed in at most one of the internal market and the external market." Applicant has studied the above-noted portions of Lupien and indeed the entire disclosure of Lupien, and submits that Lupien is deficient with regard to Claim 1.

Lupien's orders are broadcast first to an internal market (i.e., "other market participants logged into the computer executing this program"). If the orders are not executed within the system, the orders may then be routed to an external market (i.e., "one or more computerized exchanges, brokerage services, market access networks or displayed through its own network"). The routing of orders by Lupien to, first, the internal market, and then, to an external market, is a sequential routing of the orders and not a simultaneous routing. Since Lupien does not consider

a circumstance in which "a portion or all of an order [is] simultaneously available for execution in both the internal market and an external market," as recited in Claim 1, it follows that Lupien cannot teach "automatically controlling execution such that the simultaneously available portion or all of the order is executed in at most one of the internal market and the external market."

Claim 1 has also been amended to further distinguish the claim over the disclosures of May and Lupien. As indicated in amended Claim 1, the "automatically controlling includes providing a mechanism for coupling the internal and external markets such that only one of the internal and external markets maintains the order for execution by a market participant at either of the internal market or the external market." Furthermore, in Claim 1, "when one of the internal and external markets is operating in a fast symbol mode, the other of the internal and external markets operates as a router and routes the order to the market operating in fast symbol mode without posting the order at the other of the internal and external markets, and the order can be executed at only the market operating in fast symbol mode."

The above-noted features are not taught or suggested by May or Lupien. The Office Action (page 8) conceded that May does not teach the elements of former Claims 7 and 8, and instead relied on Official Notice. However, as discussed in the Examiner interview, applicant traverses the reliance on Official Notice in this regard and maintains that the basis for rejection is insufficient. The Office Action cited Korhammer, at Col. 11, lines 54-67, with respect to former Claim 6. Applicant respectfully disagrees and submits that Korhammer does not overcome the deficiencies of May, Lupien, and the Official Notice discussed above.

In view of the foregoing arguments, applicant submits that a *prima facie* case of obviousness under Section 103 has not been shown. Accordingly, the rejection of Claim 1 should be withdrawn and the claim allowed.

Claim 28

Independent Claim 28 is directed to a computer system configured to operate an internal market. The system comprises an order routing computing component in combination with an order execution computing component.

The order routing computing component comprises one or more computing devices programmed to make a portion or all of an order available for execution in the internal market and to automatically cause the same portion or all of the order to be simultaneously available for execution at an external market.

The order execution computing component comprises one or more computing devices programmed to automatically control execution of the order such that the simultaneously available portion or all of the order is executed in at most one of the internal market and the external market.

For at least reasons similar to those discussed above with respect to Claim 1, applicant submits that May and Lupien do not disclose an order routing computing component and order execution computing component as defined in Claim 28. Furthermore, Korhammer does not make up the difference. Accordingly, applicant submits that Claim 28 should be allowed.

Claim 28 should also be allowed for the additional subject matter it recites, namely, "wherein the order execution computing component is configured to automatically control execution of the order by providing a mechanism for coupling the internal market to the external market such that only one of the internal and external markets maintains the order for execution by a market participant at either of the internal market or the external market" and "wherein when one of the internal and external markets is operating in a fast symbol mode, the other of the internal and external markets is configured to operate as a router and route the order to the market operating in fast symbol mode without posting the order at the other of the internal and external markets, and the order can be executed at only the market operating in fast symbol mode."

The above-quoted subject matter was previously recited in Claim 33-35. The Office Action (page 8) conceded that May does not teach the elements of former Claims 34 and 35, and instead relied on Official Notice. Applicant traverses the reliance on Official Notice in this regard and, as discussed in the Examiner interview, maintains that this basis for rejection is insufficient. The Office Action cited Korhammer, at Col. 11, lines 54-67, with respect to former Claim 33. Nevertheless, applicant submits that this portion of Korhammer does not teach anything related to coupling an internal market to an external market such that only one of the internal and external markets maintains the order for execution by a market participant at either of the internal market or the external market. Applicant respectfully submits that Korhammer does not overcome the deficiencies of May, Lupien, and Official Notice as discussed above. The rejection of Claim 28 should be withdrawn and the claim allowed.

Claim 38

Independent Claim 38 is directed to a tangible computer-accessible medium having executable instructions stored thereon for operating an internal market. The instructions, if accessed and executed by a computer, cause the computer to receive an order that is executable at a market and automatically cause a portion or all of the order to be simultaneously available for execution in both the internal market and an external market.

Each of the internal and external markets have a plurality of market participants and are each separately capable of executing trades between the market participants. The same portion or all of the order is simultaneously available to the market participants in each of the respective internal and external markets to complete a trade. Furthermore, the instructions, if executed, cause the computer to automatically control execution of the order such that the simultaneously available portion or all of the order is executed in at most one of the internal market and the external market without chance of a duplicate execution of the simultaneously available portion or all of the order.

For at least reasons similar to the reasons discussed above in regard to Claims 1 and 28, applicant submits that May and Lupien fail to teach or suggest the above-noted elements of Claim 38. Moreover, the disclosure of Korhammer does not overcome the deficiencies of May and Lupien. Accordingly, Claim 38 should be allowed.

Claim 38 should also be allowed for reciting "wherein the executable instructions cause the computer to automatically control execution of the order by providing a mechanism for coupling the internal and external markets such that only one of the internal and external markets maintains the order for execution by a market participant at either of the internal market or the external market" and "wherein when one of the internal and external markets is operating in a fast symbol mode, the other of the internal and external markets operates as a router and routes the order to the market operating in fast symbol mode without posting the order at the other of the internal and external markets, and the order is able to be executed at only the market operating in fast symbol mode."

The foregoing subject matter in Claim 38 was previously recited in Claims 43-45. As with Claims 7, 8, 34, and 35, discussed above, the Office Action (page 8) conceded that May does not teach the elements of former Claims 44 and 45. Instead, the Office Action took Official Notice of these features as allegedly being obvious. In the Examiner interview, however, applicant traversed the Official Notice and maintained that the rejection in this regard is insufficient.

The Office Action cited Korhammer, at Col. 11, lines 54-67, with respect to former Claim 43. However, applicant submits that this portion of Korhammer does not teach anything related to coupling an internal market to an external market such that only one of the internal and external markets maintains the order for execution by a market participant at either of the internal market or the external market. Since Korhammer does not overcome the deficiencies of May, Lupien, and the Official Notice taken in the Office Action, the rejection of Claim 28 should be withdrawn and the claim allowed.

Claim 51

Claim 51 is directed to a computer system configured to operate a market and is claimed using means plus function claim terminology. Specifically, Claim 51 recites "means for automatically causing a portion or all of an order to be simultaneously available for execution in both a first market and a second market, wherein the first and second markets each has a plurality of market participants and are each separately capable of executing trades between their respective market participants, and wherein the same portion or all of the order is simultaneously available to the market participants in each of the respective first and second markets to complete a trade." Claim 51 also recites "means for automatically controlling execution of the simultaneously available portion or all of the order such that the simultaneously available portion or all of the order is executed in at most one of the first and second markets."

Lastly, Claim 51 recites "wherein the means for automatically controlling execution includes means for providing a mechanism that couples the internal and external markets such that only one of the internal and external markets maintains the order for execution by a market participant at either of the internal market or the external market" and "wherein when one of the internal and external markets is operating in a fast symbol mode, the other of the internal and external markets operates as a router and routes the order to the market operating in fast symbol mode without posting the order at the other of the internal and external markets, and the order can be executed at only the market operating in fast symbol mode."

Computer equipment for performing the cited functions is structurally described in the present application, for example, at page 4, lines 20-29, and page 5, lines 3-14, as well as other places in the application as filed.

The Office Action does not appear to discuss Claims 51 and 52. Applicant submits that the computer system of Claim 51 is patentable over May, Lupien, and Korhammer, for at least reasons similar to those discussed above with respect to Claims 1, 28, and 38. Applicant therefore requests reconsideration and allowance of Claim 51.

Dependent Claim 52 further recites "wherein the means for automatically causing a portion or all of an order to be simultaneously available for execution includes means for posting a portion or all of an order in an order book maintained by one of the first and second markets and means for directing the same portion or all of the order to be posted in an order book maintained by the other of the first and second markets." Applicant has considered the disclosures of May, Lupien, and Korhammer, and respectfully submits that the references are deficient in regard to Claim 52. Applicant therefore submits that Claim 52 is allowable, not only for its dependence on Claim 51, but also for the additional features it recites.

Claims 2-5, 9, 10, 29-32, 36, 37, 39-42, and 46-50

Dependent Claims 2-5, 9, 10, 29-32, 36, 37, 39-42, and 46-50 depend either directly or indirectly from Claims 1, 28, and 38 and are allowable over May, Lupien, and Korhammer for at least the same reasons as Claims 1, 28, and 38. Moreover, Claims 2-5, 9, 10, 29-32, 36, 37, 39-42, and 46-50 present subject matter that is separately and additionally allowable over May, Lupien, and Korhammer.

For example, Claim 47 recites the method of Claim 1, in which "the automatically controlling includes operating the internal market according to a two-phase protocol in which in a first phase, permission is obtained from a controlling process to execute the order, and in a second phase, the order is executed only if permission from the controlling process is obtained." The Office Action rejected Claim 47, citing May and alleging that "[m]aintaining control of the trading process implies these features." However, May does not teach such operation of a market as recited in Claim 47, but instead teaches a conventional market in which an order is immediately executed when a user places an order.

As another example, Claim 50 recites the method of Claim 1, in which automatically causing a portion or all of an order to be simultaneously available for execution includes "causing the portion or all of the order that was posted in an order book maintained by one of the internal and external markets to be simultaneously posted in an order book maintained by the

other of the internal and external markets." Applicant respectfully submits that May fails to teach or suggest such a method of simultaneously posting an order (or portion thereof) in order books of different markets. Applicant has also considered Lupien and Korhammer and finds no disclosure in these references that overcomes the deficiencies of May.

Applicant respectfully disputes the propriety of the Official Notice taken at page 9 in the Office Action. As noted above, applicant respectfully submits that the Official Notice is insufficient to cure the deficiencies of May, Lupien, and Korhammer regarding operation in "fast symbol mode," as claimed, and does not support an obviousness rejection of Claims 7, 8, 34, 35, 44, 45, and 50.

Furthermore, applicant respectfully disagrees that elements of the dependent claims are statements of intended use, as alleged at pages 7-9 in the Office Action. The dependent claims recite additional elements that further positively define the method, system, and computer-accessible medium as claimed in Claims 1, 28, 38, and 51.

CONCLUSION

Applicant respectfully requests reconsideration and allowance of Claims 1-5, 9, 10, 28-32, 36-42, and 46-52 in view of the foregoing amendments and remarks. Should any issues remain needing resolution prior to allowance, the Examiner is invited to contact the undersigned counsel by telephone.

Respectfully submitted,

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